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09/903,390	07/09/2001	Dean Furbush	09857-058001	9348
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FISH & RICHARDSON PC			EXAMINER	
P.O. BOX 1022			SUBRAMANIAN, NARAYANSWAMY	
MINNEAPOLIS, MN 55440-1022				
			ART UNIT	PAPER NUMBER
			3695	
			NOTIFICATION DATE	DELIVERY MODE
			12/26/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

# Office Action Summary

**Application No.**

09/903,390

**Applicant(s)**

FURBUSH ET AL.

**Examiner**

Narayanswamy Subramanian

**Art Unit**

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to applicant's communication of September 16, 2008. Amendments to claim 1 have been entered. Claims 1-21 are pending and have been examined. The rejections and response to arguments are stated below. Applicants are requested to note the Examiner's new art unit number (**AU 3695**) in their reply to this office action.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Claim 1 recites the limitations of "a client computer station" and "a server computer system". It is not clear how the client station in claim 1 is related/connected/linked to the server system of claim 2. It is not clear how these two elements are structurally related to make the system operable. Hence the scope of the claim is not clear to one of ordinary skill in the art. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. Dependent claims are rejected by way of dependency on a rejected independent claim. Appropriate correction is required.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is drawn to a system but recite the steps

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of a method. Claims 1-17 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble of claim 1 recites a system. The claim starts by claiming an element of an apparatus “a client station for entering an order” and then discusses the specifics of a method “the client station displaying a graphical user interface that allows the user to choose a priority type for how the order interacts with contra side quotes/orders in the market”. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F. 2d 1200, 1217 (Fed. Cir. 1991). Similar defects are present in other dependent claims for instance claims 2, 3, 5-11. Applicants are respectfully requested to correct these defects in response to this office action. Appropriate clarification/correction is required for all these claims.

Claims 1-21 are also rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. These claims recite “entering receiving directed order” and “delivering the order, as a liability or non-liability order”. The omitted elements are the elements relating a directed order to a liability or non-liability order. Hence the scope of the claim is not clear to one of ordinary skill in the art. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. Dependent claims are rejected by way of dependency on a rejected independent claim. Appropriate correction is required.

The art rejections below are interpreted in view of the 112, second paragraph rejections above.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over NASD Rulemaking Reference (Reference AV in IDS of October 19, 2007).

Claims 1, 12 and 17, discloses a method for trading of securities comprising receiving by a computer system a directed order to begin a negotiation process with a particular quoting market participant (See Reference AV Pages 10-11); and delivering by the computer system the order, as liability or non-liability order in accordance with how the quoting market participant chooses to receive directed orders (See Reference AV Pages 12-43). As disclosed on page 33 of the reference the quoting market participant can use the exception to Firm Quote rule and supplemental size feature to choose how the participant wants to receive the order. The limitation “to begin a negotiation process with a particular quoting market participant” is interpreted as an intended use limitation. A system for trading of securities with a client computer station for entering a directed order and a server computer system for receiving the directed order, the-server system delivering the order and a computer program product for trading of securities by performing the steps of the claimed method are implied by the disclosure. In the alternative, system for trading of securities with a client computer station for entering an

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order and a server computer system for receiving and delivering the order and a computer program product for trading of securities by performing the steps of the claimed method are old and well known in the electronic trading of securities.

Claim 4, the feature of system of claim 1 further comprising a second client station for entering non-directed orders that are orders for a security that are not sent/routed to a particular quoting market participant is implied by the disclosure of Reference AV. In the alternative this feature is old and well known in the electronic trading environment. Having a second client station for entering non-directed order makes the process of entering orders easier and more efficient.

Claims 2-3, 5-11, 13-16, and 18-21, the features in these claims are taught by the disclosure of Reference AV.

### ***Response to Arguments***

6. In response to Applicant's arguments "Claims 1-11 are directed to a single statutory class a machine, i.e., a system", the Examiner respectfully disagrees. As discussed in the rejection, the claim (claim 1) starts by claiming an element of a machine "a client station for entering an order" and then discusses the specifics of a method "the client station displaying a graphical user interface that allows the user to choose a priority type for how the order interacts with contra side quotes/orders in the market". A claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F. 2d 1200, 1217 (Fed. Cir. 1991). Similar defects are present in other dependent claims for instance claims 2, 3, 5-11.

In response to Applicant's arguments "Claim 1 recites: a client computer station ... a server computer system receiving the directed order ...." Claim 1 recites the

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necessary cooperation to make the claim structurally related in that it requires the server to receive the directed order that was entered by the client system.”, the Examiner respectfully disagrees. As discussed in the rejection, it is not clear how these two elements, namely a client computer station and a server computer system are structurally related to make the system operable. Hence the scope of the claim is not clear to one of ordinary skill in the art. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. Claims must particularly point out and distinctly claim the invention. The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. (See MPEP 2173). Similar response applies to Applicant’s arguments about rejection of claims 1-21 under 35 USC 112, second paragraph “The omitted elements are the elements relating a directed order to a liability or non-liability order. Again the specification is clear on these terms and one skilled in the art could consult the specification without importing into the claims limitations from the specification”. Claims must particularly point out and distinctly claim the invention. The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. (See MPEP 2173). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's other arguments have been fully considered but they are either moot or not persuasive.

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*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on the attached form PTO-892.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles R. Kyle can be reached at (571) 272-6746. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/  
Primary Examiner  
Art Unit 3695

December 21, 2008